



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,303	06/23/2000	Scott Lorenz	5053-36000	1772

7590 11/12/2004

ERIC B. MEYERTONS, ESQ.
CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/603,303

Applicant(s)

LORENZ, SCOTT

Examiner

Carolyn M Bleck

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1-18 and 20-22.Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17 June 2004.
10. ☐ Other: _____


ALEXANDER KALINOWSKI
PRIMARY EXAMINER

Art Unit: 3626

The amendments to claim 1 do not affect the interpretation of the claim made by the Examiner in the previous Office Action. Therefore, claim 1 is rejected for the same reasons given in the previous claim, and incorporated herein.

Continuation of 5: A request for reconsideration has been considered but does not place the application in condition for allowance because:

Applicant's arguments filed 18 October 2004 have been fully considered but they are not persuasive.

Applicant's arguments are discussed below.

Applicant argues the following features are not taught by the applied art:

"an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to: estimate a value of an insurance claim as a function of insurance claim assessment data wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time" as recited in claims 1 and 29.

The Examiner respectfully disagrees with the Applicant. Firstly, the Applicant appears to argue that the insurance claim processing server is different from Borghesi's communications server. In response, it is respectfully submitted that the Borghesi's communications server performs the functions of claims 1 and 29. While the server may not be named an "insurance claim processing server," it still is capable of estimating the value of an insurance claim. Secondly, the Examiner relied upon DeFrancesco for the limitations of a sequence of insurance claim processing steps executable to complete an insurance claim processing task.... However, Applicant appears to solely argue the features of Borghesi when the Examiner clearly relied on DeFrancesco for those features. Lastly, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has provided motivation directly from the prior art. In addition, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that the limitations of claims 2, 8-9, and 16 are not taught by the applied prior art. The Examiner respectfully submits that these limitations were clearly disclosed in the previous Office Action. Therefore, the rejection is maintained.